

REMARKS

Claims 1, 5-11, and 20-34 are pending in the present application. Claims 8-10, 22, 23, and 31-34 have been withdrawn, with claims 1, 5-7, 11, 20, 21, and 24-30 under consideration according to the examiner. No claims have been amended in this paper.

The examiner rejected claims 1, 5, 6, 11, 20, 21, 24 and 25-30 under 35 U.S.C. § 102(b) over Lenker (USPN 5,843,158). This rejection is respectfully traversed.

Applicant is grateful for the examiner's concession that Lenker `158 is silent as to the heat bond failing during expansion, as per the current Office action, pages 2-3.

Applicant contends that Lenker `158 does not teach all elements of independent claim 1 or claim 25. Claim 1 recites that the "endoprosthesis [is] disposed on the expandable member." According to the examiner, the expandable member is shown in Fig. 2 of Lenker `158 and identified as part no. 48. Applicant notes that part no. 48 in Fig. 2 of Lenker `158 is a nosecone (48) disposed at the distal end of the guide wire shaft (44) used probably as an atraumatic tip to steer the guide wire. (See Lenker `158, col. 7, ll. 30-31.) The endoprosthesis (10) in Fig. 2 is not disposed on a balloon; in fact, it is a self-expanding prosthesis so no balloon is needed. (See Lenker `158, col. 7, ll. 32-36, "Prosthesis 10 is radially *compressed* and restrained... Runners 42 are formed from a hard material, and distribute the *expansion load* of prosthesis 10" Emphasis added.)

Therefore, Lenker `158 does not teach "an expandable member" or "an endoprosthesis disposed on the expandable member." At least for this reason, claim 1 is distinguishable over Lenker `158.

Claim 25 recites "wherein the heat bond fails during expansion of the stent." The examiner conceded that Lenker `158 is silent as to the heat bond failing during expansion, as per the current Office action, pages 2-3. At least for this reason, claim 25 is distinguishable over Lenker `158. This rejection should therefore be withdrawn.

The examiner rejected claims 1, 5, 6, 11, and 24 under 35 U.S.C. § 102(e) over Lenker (USPN 6,878,161). This rejection is respectfully traversed.

Applicant contends that claim 1 dates back to the parent patent, U.S. Patent No. 6,629,992 (Bigus et al.), which has a filing date of June 29, 2001. The subject matter of claim 1 is disclosed in the parent patent at, for example, col. 6, ll. 54-56: “The expansion of the expandable member 24 expands the stent 14, causing the biocompatible sheath 16 to fail.”

Since the subject matter of claim 1 dates back to the constructive conception date of June 29, 2001 (i.e., the filing date of the parent), Lenker `161 is not a 35 U.S.C. § 102(e) prior art to claim 1. That is, since claim 1 dates back at least to June 29, 2001, which is before the April 25, 2002 filing date of Lenker `161, the claimed invention was not described in a patent granted on an application for patent by another filed in the U.S. before the invention by the applicant for patent. 35 U.S.C. § 102(e)(2). Therefore, Lenker `161 is not prior art under § 102(e) to claim 1, and the reference cannot be used to reject this claim.

Applicant respectfully notes that this exact issue was vetted already in applicant's response filed June 26, 2006, in response to the same rejection. Applicant kindly asks that this rejection be withdrawn for the reason given above.

The examiner rejected claims 20, 21, and 28-30 under 35 U.S.C. § 103(a) over Lenker `158 and Solar (USPN 5,549,635). This rejection is respectfully traversed.

Claims 20, 21, and 28-30 are all dependent claims. Applicant relies here on the arguments set forth above in connection with the independent base claims to distinguish over the cited art. The rejected dependent claims are therefore patentable over the cited art for the same reasons given above in connection with the independent base claims 1

and 25. Applicant respectfully disagrees with the examiner's other grounds for rejection not specifically addressed above.

In view of the foregoing, all claims are now in condition for allowance. Reexamination and reconsideration of the application are respectfully requested and allowance at an early date is solicited. The Commissioner is authorized to charge deposit account no. 06-2426 for any unforeseen fees arising in connection with the filing of this paper.

Respectfully submitted,
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